

REMARKS

Claims 48, 52, 54, 61 and 66 have been amended. New dependant claims 67-74 have been added. Claims 46 - 74 are pending. Claims 1 - 45 are cancelled. In accordance with the Examiner's request, claims 1-31, drawn to an invention that was non-elected with traverse in the paper filed on June 16, 2006 are canceled without prejudice. Reexamination and reconsideration of the application, as amended, are respectfully requested.

New dependant claims 67-74 have been added. Support for dependant claims 67-70 may be found, for example, at paragraph 0047 of specification, which states that the touchpad may also float within a space of the frame. Support for dependant claims 71-74 may be found, for example, at paragraph 0048 of the specification, which states that the touchpad may be in the form of a button that performs one or more clicking actions. No new matter has been added.

Claim 52 was objected to under 37 CFR 1.75(a). In response, and in accordance with the examiner's indication, --a selection for-- has been inserted immediately after "comprises" in line 1 for clarification.

Claims 48-49 were rejected under 35 U.S.C. 112, second paragraph. Accordingly, claim 48 has been amended to provide antecedent basis for the recitation of "the rotational input device" in line 3. It is respectfully submitted that this amendment also overcomes the rejection of claim 49, which depends from claim 48.

Claims 46-49, 52-57, 60-62, 32-45 were rejected under 35 U.S.C. 102(b) as being anticipated by Molne (USP 6,243,080). The Examiner stated:

"As to claims 46-49, 52, 54-57, 61, 62, and 66, Molne discloses a portable media player (a wireless communication device 10, see Fig. 1, col. 7, lines 30-34) comprising a housing (see Fig. 1) including a frame (a casing 17, see Fig. 1 or 2); and a touchpad/rotational input device (a touch sensitive panel 30, see Figs. 2-5) disposed within the housing (see Figs. 1 and 3) and capable of a gimbal action relative to the housing, wherein the gimbal action of the user input apparatus enables a user of the portable media player to make media selections and enables the touch panel to pivot relative to the frame(17) and the housing (see Figs. 2-5 and the corresponding description, specifically col. 6, lines 31-45). Molne further teaches a touchpad (30) configured to receive a rotational input from a user's finger by virtue of the description at col. 3, lines 16-32.

Further regarding to the claimed limitations, "the touchpad/rotational input device distinct zones, each of the zones having a corresponding indicator for generating a distinct user input signal when the touchpad/rotational input device is depressed in the region of the

zone", Molne discloses at col. 6, lines 31-46 that the touch-sensitive panel 30 (i.e., the claimed rigid user interface platform) including a portion corresponding to the keypad, so that each key of the keypad corresponding to an input zone having a corresponding one of the movements indicator for generating a distinct user input signal when the touch-sensitive panel 30 (i.e., the claimed rigid user interface platform) is moved in the region of the input zone. Based on the mentioned passage, Molne implicitly discloses the above underlined limitations.

Accordingly, all the limitations of these claims are read in the Molne reference.

As to claims 53, 60, and 65, Molne discloses an input surface of the touchpad/rotational input device substantially co-planer with an external surface of the housing (see Fig. 3)."

The rejection of claims 32-45 is made moot by the cancellation of these claims. The rejection of claims 46-49, 52-57 and 60-62, as amended, is respectfully traversed.

Claims 46-49, 52-57 and 60-62 are each generally directed to a portable media device comprising a number of elements in combination. For example, representative claim 46 is directed to a portable media device comprising a housing and a touchpad. The touchpad is configured to receive rotational inputs and is capable of a gimbal action relative to the housing. The gimbal action of the touchpad is configured to enable a user of the portable media device to make a selection.

A similar combination of elements is neither disclosed nor suggested by Molne. There is no teaching or suggestion in Molne of a combination including a touchpad configured to receive rotational inputs and capable of a gimbal action relative to a housing. There is no teaching or suggestion in Molne of a combination wherein the gimbal action of a touchpad enables a user of a portable media device to make a selection.

Molne discloses a touch-sensitive panel 30. Molne's touch sensitive panel does not gimbal. Molne's panel 30 exhibits only one degree of freedom. In one embodiment Molne's touch-sensitive panel only moves vertically, between an "up" or "normal" position (shown in Figure 2) and a "down" or "select" position (shown Figure 3)(See Molne at column 2, lines 14-36 and claims 1, 2, 6, 7, 13 and 14). In a second embodiment Molne's touch-sensitive panel is attached to the frame by a hinge along one side of the panel. The opposite side of the panel is urged upward by a spring. In this second embodiment the touch-sensitive panel rotates about the hinge between a first position and a second position (See Molne at column 5, lines 14-24 and claim 7).

There is no teaching or suggestion in Molne of a touch sensitive panel that gimbals or has multiple degrees of freedom. There is no teaching or suggestion in Molne of a touch sensitive panel that both rotates and moves vertically, combining both the vertical and hinged embodiments disclosed in Molne. Molne consistently refers to the vertical and hinged embodiments as separate and distinct alternative embodiments, never as a combination. See, for example, column 2, lines 14-15, where Molne states that the touch panel can be moved by rotation “or” by vertical displacement, not by rotation “and” vertical displacement.

Molne’s consistent reference to these two embodiments as separate and distinct alternatives is not surprising, since a combination of Molne’s hinged and vertical embodiments would be inoperable. If Molne’s touch panel is attached to the frame by a hinge, as Molne teaches, then the panel is strictly limited to rotational movement about the hinge. Molne’s hinged touch panel can rotate, but it cannot be displaced vertically relative to the frame because the touch panel is connected to the frame by the hinge. To enable vertical displacement, as shown in Figures 2 and 3 of Molne, the touch panel must be unhinged. Consequently, a combination of Molne’s hinged and vertical embodiments would be inoperable. There is certainly no teaching or suggestion in Molne of combining these separate and distinct alternative embodiments. Nor is there any teaching or suggestion in Molne that a touch panel with multiple degrees of freedom would provide any benefit or advantage over the touch panel with one degree of freedom disclosed in Molne.

Claims 54 and 61 have been amended to recite a portable media device comprising a combination including a rotational input device configured to move in multiple degrees of freedom relative to the housing. Claim 66 has been amended to recite a portable media device comprising a combination including a touch pad movable in multiple degrees of freedom relative to the frame. Support for the amended claims can be found, for example, in the present application at paragraph 0061, which describes a gimbal touch pad that may move in multiple degrees of freedom relative to the housing. No new matter has been added.

A similar combination of features is neither disclosed nor suggested by Molne, viewed alone or in combination with any other reference. It is therefore respectfully submitted that claims 46-49, 52-57 and 60-62, as amended, overcome the anticipation rejection based on Molne and are in condition for allowance.

Claims 50, 51, 58, 59, 63 and 64 were rejected under 35 U.S.C. 1.03(a) as being unpatentable over Molne as applied to claims 46, 54, and 61, and further in view of Trent (US 2004/0252109 A1). Claims 50-52, 58, 59, 63 and 64 were rejected under 35 U.S.C. 103(a) as being unpatentable over Molne and further in view of Matzke (USP 4,736,191). Claims 46-66 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 7, 11, and 16 of U.S. Patent No. 7,046,230 in view of Molne.

These rejections are respectfully traversed for the reasons stated above with respect to claims 46-49, 52-57 and 60-62


The additional references of Trent, Matzke and (in the case of the nonstatutory obviousness-type double patenting rejection) USP 4,736,191 fail to compensate for the fundamental deficiencies in Molne. There is no teaching or suggestion in any of these references, alone or in combination, of a combination including a touch sensitive panel that gimbals or has multiple degrees of freedom.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 106842000600.

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